THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RONALD A. WAGSTAFF

Appeal No. 97-0922
Application 08/314,281[1]

ON BRIEF

Before KRASS, FLEMING and TORCZON, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

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[1] Application for patent filed September 30, 1994.

This is a decision on appeal from the final rejection of claims 1 through 20, all of the claims in the application.

The invention pertains to a signal processing filter and is exemplified by representative independent claim 1 reproduced as follows:

1. A filter, said filter comprising:

means for receiving a time series x_i of power realizations, i = 1, 2,..., N;

means for selecting an order z of said filter, said z a real number not equal to 0, 1, or -1; and

means for determining a_z, wherein a_z is proportional to:

No references are cited against the claims.

Claims 1 through 20 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite.

Reference is made to the brief and answer for the respective details of the positions of appellant and the examiner.

OPINION

The examiner contends that it is unclear as to whether or not the "means for receiving a time series x_i of power realizations" is merely a line that carries x_i or whether it includes means to generate x_i [answer-page 2]. Further, the examiner contends that the "means for selecting an order z of said filter" is indefinite because the specification discloses no apparatus for performing this function [answer-page 2].

With regard to the requirement of the second paragraph of 35 U.S.C. § 112, the definiteness of claim language is analyzed, not in a vacuum, but in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. See In re Moore, 439 F.2d 1232, , 169 USPQ 236, (CCPA 1971).

With regard to the means for receiving a time series of power realizations, it is clear to us, from page 5 of the

specification, i.e., "Spectrum analyzer 16 produces for each frequency bin of interest a series of signals x_i, 1 [sic, i]=1,2,...,N corresponding to signal power at the frequency of the bin...at the time each x_i was sampled," and from Figure 1, wherein the signals from element 16 are shown being input to elements 18 and 20, that this "means" comprises elements 18 and/or 20 since elements 18 and 20 receive the time series of power realizations from element 16.

If the examiner is seeking more recitations in the claims regarding specific structure, this would appear to be a matter of breadth rather than indefiniteness. The two should not be confused. In re Miller, 441 F.2d 689, , 169 USPQ 597, (CCPA 1971).

With regard to the "means for selecting the order z of said filter," the examiner has a point, at least with regard to the apparatus claims reciting "means plus function," in the sense that there appears, at first glance, to be no disclosed supporting structure for the "means for selecting."

While the sixth paragraph of 35 U.S.C. 112 sanctions the use of "means plus function" language, the specification must still have an adequate disclosure as to what is meant by

that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of 35 U.S.C. 112. In re Donaldson, 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994). Also see In re Dossel, 115 F.3d 942, , 42 USPQ2d 1881, (Fed. Cir. 1997). However, in the instant case, in view of the state of the filter art, we find that the artisan would have understood the filter 20 of the instant invention to be a computer for running the claimed algorithm and that it then becomes clear that the "means for selecting an order z of said filter" would be any means for inputting that value into the computer.

While we have found for appellant in this case, we note, in passing, that we find appellant's arguments to have been unpersuasive in reaching our decision. Appellant alleges that the examiner apparently believes "that claims and drawing figures must, necessarily, be co-extensive in scope" [brief-page 5]. However, we do not understand the examiner to have been asserting such. Rather, the examiner was merely questioning the metes and bounds of the claimed invention in

terms of the meaning of the claimed "means for receiving..." We merely hold that the examiner's challenge to the definiteness of the claims in this regard is unreasonable in view of the instant disclosure.

With regard to the claimed "means for selecting....," again, while we find for appellant because we hold that the filter is actually a computer for performing the recited algorithm, and therefore, the "means for selecting..." is an input means for inputting the data into the computer, appellant's argument, per se, that in order to sustain the examiner's rejection, we would need to conclude that the artisan does not know how to vary a parameter of a filter and that this "strains belief," [brief-page 6] is unpersuasive. After all, the examiner's rejection was not based on the enablement clause of 35 U.S.C. 112, first paragraph, but, rather, on the second paragraph of 35 U.S.C. 112. Accordingly, all that was required of appellant to overcome the rejection was to point to the section of the disclosure identifying the claimed "means for selecting."

The examiner's rejection of claims 1 through 20 under 35 U.S.C. 112, second paragraph, is reversed.

REVERSED

ERROL A. KRASS Administrative Patent Judge	)
MICHAEL R. FLEMING Administrative Patent Judge	) BOARD OF PATENT) APPEALS AND) INTERFERENCES
RICHARD TORCZON Administrative Patent Judge	)

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